

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Peter Herold

Art Unit: 1626

Examiner: Shameem, Golam M

APPLICATION NO: 10/586,814

FILED: July 24, 2006

FOR: DIAMINO ALCOHOLS AND THEIR USE AS RENIN INHIBITOR

**MS: General**

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

**PETITION REGARDING PATENT TERM ADJUSTMENT UNDER C.F.R. §1.705(b)**

Sir:

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 585 days. This application is being filed with the payment of the issue fee, as required by 37 C.F.R. § 1.705 (b).

**I. Fee**

As required by 37 C.F.R. § 1.705(b)(1), this application is accompanied by a request to charge Deposit Account No. **50-4409** for \$ 200.00 to cover the required fee (as defined in 37 C.F.R. § 1.18(e)). Please charge any deficiencies or any additional fees due in response to this request to Deposit Account **50-4409**.

**II. Statement of the Facts Involved**

**A. Correct Patent Term Adjustment**

The Notice of Allowance, which was mailed on October 23, 2009, indicated a preliminary Patent Term Adjustment of 403 days.

Patentee has calculated an initial patent term adjustment of 585 days based on the following facts:

### **Case Law**

In *Wyeth v. Kappos*, 2010 U.S. App. Lexis 300, the Federal Circuit affirmed the interpretation of 35 U.S.C. § 154(b)(2) by the District Court of the District of Columbia in *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 2008. The Federal Circuit affirmed the determination that the USPTO misconstrued the first sentence of 35 U.S.C. § 154(b)(2)(A), and as a result, improperly denied Wyeth a portion of patent term to which Wyeth was entitled under 35 U.S.C. § 154.

In the opinion, the Court stated that "the PTO's view is that any administrative delay under § 154(b)(1)(A) overlaps any 3-year maximum pendency delay under § 154(b)(1)(B): the applicant gets credit for 'A delay' or for 'B delay,' whichever is larger, but never A + B." However, Plaintiff Wyeth argued that the § 154(b)(1)(A) and § 154(b)(1)(B) period overlap only if they occur on the same calendar day or days. The Court determined that Wyeth's construction of § 154(b)(2)(B) was correct.

Simply put, the holding of the Court is that the excluded overlap recited in the first sentence of 35 U.S.C. § 154(b)(2)(A) only occurs if a 35 U.S.C. § 154(b)(2)(A) period and a 35 U.S.C. § 154(b)(2)(B) period run concurrently. As such, a patent holder is entitled to recoup the 35 U.S.C. § 154(b)(2)(A) period that falls outside of the 35 U.S.C. § 154(b)(2)(B) period in addition to the 35 U.S.C. § 154(b)(2)(B) period itself.

### **Relevant Dates**

The above identified application has a 35 U.S.C. § 371 filing date of July 24, 2006.

The first Office Action, which was a Restriction Requirement, was mailed on January 9, 2009, resulting in a PTO delay of 473 days beyond the 14 months provided by 35 U.S.C. § 154(b).

A Response by Patentee was filed March 9, 2009, within the 3 months provided by 35 U.S.C. § 154(b).

An Office Action was mailed April 3, 2009, within the 4 months provided by 35 U.S.C. § 154(b).

A Response by Patentee was filed July 2, 2009, within the 3 months provided by 35 U.S.C. § 154(b).

A supplemental Amendment was filed September 10, 2009, resulting in a patentee delay of 70 days beyond the 3 months provided by 35 U.S.C. §154(b).

A Notice of Allowance was mailed October 23, 2009, within the 4 months provided by 35 U.S.C. §154(b).

The issue fee has been paid on January 22, 2010 in a paper accompanying the instant petition, within the 3 months provided by 35 U.S.C. §154(b).

Accordingly, the initial PTO adjustment based on delay under 35 U.S.C. § 154(b)(1)(A) is 473 days.

The initial 35 U.S.C. § 154(b)(1)(B) period for the instant application began on July, 24, 2009 (three years after the filing date of July 24, 2006) and will end on the date of issuance. The initial 35 U.S.C. § 154(b)(1)(B) period running from July, 24, 2009 until payment of the issue fee (January 22, 2010) is 182 days.

There was 0 days of PTO delay under 35 U.S.C. § 154(b)(1)(A) that overlap with the initial 35 U.S.C. § 154(b)(1)(B) period that should be excluded from the patent term adjustment calculation under the holding of *Wyeth v. Kappos*.

There were 70 days of Applicant delay under 35 U.S.C. §154(b)(2)(C).

Accordingly, the sum of the 35 U.S.C. § 154(b)(2)(B) delay (182 days) and 35 U.S.C. § 154(b)(2)(A) delay (473 days) less the overlap days (0 days) and less Applicant delay days (70 days) results in an initial PTA of 585 days.

The initial PTA printed on the Notice of Allowance is only 403 days, which the USPTO is presumed to have calculated using the method considered proper before the holding of *Wyeth v. Kappos*. Applicants therefore respectfully request reconsideration of the initial PTA calculation.

#### **B. Terminal Disclaimer**

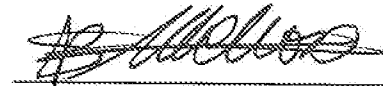
The above-identified patent is subject to a Terminal Disclaimer filed September 10, 2009 over pending application Number 10/593,461. Patentee disclaims the terminal part of the patent granted on the instant application that would extend beyond the expiration of any patent granted on the pending application Number 10/593,461.

**C. Reasonable Efforts**

Any applicant delays under 37 C.F.R. § 1.704 are set forth above. There were no other circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

Respectfully submitted,

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